

REMARKS

Claims 5 and 7 remain in connection with the present application. Claims 5 is the sole remaining independent claim. Reconsideration and allowability of the claims is respectfully requested.

Prior Art Rejections

The Examiner has rejected claims 5 and 7 under 35 U.S.C. § 103 as being unpatentable over Dick (U.S. Patent No. 3,671,814) in view of Moran et al. (U.S. Patent No. 5,784,244). This rejection is respectfully traversed.

Independent claim 5 of the present application requires “a control device of a switch gear drive,..., wherein after a switching command, the control device does not affect an output quantity for controlling the coil until a flux threshold value of the actual values of the drive-specific switching parameters is attained.” Thus, an actual flux threshold value is used to determine when a coil is controlled.

The primary patent document used to reject the claims of the instant application is that of the Dick patent. Dick teaches a control system responsive to a field generated by an electromagnet. According to Dick, electromagnet 1 includes a coil 2, an iron cladding 3 that surrounds the coil 2, and an armature 4 that is actively moveable within the coil 2. Associated with the electromagnet 1 is an electric circuit that includes a field resistor 8. According to the disclosure, the field resistor 8 may be constituted by a semiconductor element with alters its resistance in the same sense as a change of a traversing magnetic flux. (See column 2, lines 26-30 of Dick for example).

In the current Office Action, the Examiner maintains that it is an actual flux value that is used to dictate whether the coil 2 is energized or not. However, the disclosure of the Dick patent

actually contradicts the assertion made by the Examiner, that the flux value directly causes energizing or de-energizing of the coil 2. According to Dick, the coil 2 is energized in accordance with a reduction in resistance of the field resistor 8. Furthermore, the coil is de-energized when there is an increase in resistance in the field resistor 8. (See column 3, lines 22-25 of Dick for example). Thus, for at least the aforementioned reasons, Applicants respectfully submit that Dick fails to teach or suggest at least the aforementioned limitation of independent claim 5 of the present application.

Applicants further submit that even assuming *arguendo* that Moran et al. could be combined with Dick, which Applicants do not admit, Moran et al. would fail to makeup for at least the aforementioned deficiency of Dick. Moran et al. has merely been relied upon by the Examiner to show an solenoid system used in conjunction with a switch gear application. Moran et al. fails to teach or suggest at least the aforementioned limitation of claim 5, and thus, even assuming *arguendo* that it could be combined with Dick, Moran et al. would fail to make up for the aforementioned deficiencies of Dick.

In addition, Applicants respectfully submit that the Examiner has not provided adequate motivation as to why one of ordinary skill in the art would be led to combine the teachings of Moran et al. with those of Dick. Specifically, the Examiner merely rendered only his opinion as why one of ordinary skill in the art would be led to combine the teachings of the references, which is not “evidence” as will be explained as follows.

As set forth *In re Dembiczak*, 50 USPQ 2d 1614 (Fed. Cir. 1999), to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the Applicants. The motivation, suggestion, or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill in the art, or in some cases,

the nature of the problem to be solved. See *Dembiczak*, 50 USPQ at 1614 (Fed. Cir. 1999). As further set forth *In re Sang Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002), in order to make a proper combination of references, the Examiner must provide evidence as to why one of ordinary skill in the art would have been motivated to select and combine the referenced teachings. Relying on common knowledge or common sense of a person of ordinary skill in the art, without any specific or suggestion of this in a particular reference is not a proper standard for reaching the conclusion of obviousness.

If the Examiner is relying on personal knowledge to support a finding of what is known in the art, the Examiner must provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) and MPEP 2144.03(c). Accordingly, for at least the aforementioned additional reasons, the Examiner is respectfully requested to withdrawal the rejection or to provide an Affidavit or Declaration as set forth above if the rejection is to be maintained.

Still further, the Dick reference, particularly in line 26 of column 3, states that an oscillating movement is to be generated. For that reason, Applicants respectfully submit that a person of ordinary skill in the art, even assuming *arguendo* that he or she takes it into consideration at all, does not receive any teaching or suggestion for creating a control device of a switch gear as claimed. Rather, the person of ordinary skill in the art would most likely be led to try and solve the problem in a different manner, such as that taught by Moran et al., which takes a totally different path from that of the present invention as set forth in claim 5 for example. A person of ordinary skill in the art would not need or be led to any other conclusion, unless they viewed Applicants' invention in hindsight. Such use of hindsight is impermissible and thus, for at least the aforementioned additional reasons, the Examiner's rejections should be withdrawn.

Accordingly, withdrawal of the Examiner's rejection and allowance of claim 5 is respectfully requested in connection with the present application. With regard to dependent claim 7, this claim is allowable for at least the reasons previously set forth regarding independent claim 5.

Entry of Amendment After Final

Initially, Applicants respectfully request entry of the present Amendment After Final in that the claims of the application have not been amended in any way. Thus, entry of the Amendment will not raise any new issues requiring further consideration and/or search. Further, as a Notice of Appeal has already been filed in connection with the present application, Applicants respectfully request entry of the present Amendment upon the filing of an Appeal Brief in connection with the present application.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of claims 5 and 7 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below .

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants hereby petition for a two (2) month extension of time for filing a reply to the outstanding Final Office Action and submit the required \$420 extension fee herewith.

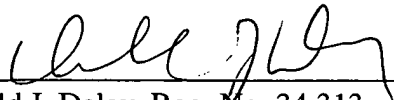
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any

additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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